

Application No.: 10/586,482
Art Unit: 3637

Amendment under 37 C.F.R. §1.111
Attorney Docket No.: 062661

AMENDMENTS TO THE DRAWINGS

Please amend Fig. 5 as set forth in the attached Replacement Sheet.

REMARKS

Reconsideration of this application, as presently amended, is respectfully requested.
Claims 1-11 are pending in the present application. Claims 1-11 stand rejected.

Objection to the Abstract

In the Office Action, the Examiner reminds applicants of the proper language and format for an Abstract of the Disclosure, noting that the Abstract should be in narrative form and generally limited to a single paragraph within the range of 50 to 150 words. The Examiner also notes that phrases that can be implied (e.g., “the present invention provides”) should be avoided.

The Abstract has been amended to obviate the objection thereto by limiting the Abstract to a single paragraph, reducing its length to 150 words or less, and improving form in accordance with preferred U.S. practice.

Withdrawal of the objection to the Abstract is respectfully requested.

Objection to the Drawings

The drawings were objected to under 37 CFR §1.83(a) for allegedly failing to show every feature of the invention specified in the claims. More particularly, the Examiner asserts that the “tape scale” recited in claims 3 and 6 is not shown in the drawings.

The claimed “tape scale” is shown in Fig. 5 of the drawings. For example, page 7, lines 12-14 of the specification as originally filed refer to a “tape scale 20” shown in Fig. 5. However, originally filed Fig. 5 does not include a reference numeral “20” that designates the “tape scale”.

Therefore, Fig. 5 has been amended, in accordance with the attached Replacement Sheet, to include a reference numeral 20 that designates the “tape scale”. Support for this amendment is provided, e.g., on page 7, lines 12-14 of the specification as originally filed.

Reconsideration and withdrawal of the objection to the drawings are respectfully requested.

Claim Rejection – 35 U.S.C. §112, first paragraph

Claims 3, 5, 6 and 9-11 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. More specifically, the Office Action asserts “The specification and claims call for a tape scale and end plates provided at both ends of the guide block body. However, the specification, drawings and claims fail to clearly define such and how such structures perform as recited.” For the reasons set forth in detail below, this rejection is respectfully traversed.

The Manual of Patent Examining Procedure (MPEP) §2163, in its guidelines regarding the written description requirement of §112, first paragraph, instructs “When a disclosure describes a claimed invention in a manner that permits one skilled in the art to reasonably conclude that the inventor possessed the claimed invention the written description requirement is satisfied.” Further, to satisfy the written description requirement all that is required is that the applicant must convey “with *reasonable clarity* to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention now claimed.” [Emphasis added] (MPEP §2163.02). Still further, it is noted that the Court of Appeals for the Federal Circuit has

held that to satisfy the written description requirement, it is not necessary that the application describe the claim limitations *exactly*, but only so clearly that persons of ordinary skill in the art to which the invention pertains would recognize from the disclosure that the applicant's invention included those limitations.

As noted above, the test for determining whether the written description requirement is satisfied is whether the originally filed disclosure *reasonably* conveys to a person having ordinary skill in the art that the applicant had possession of the subject matter claimed. As will be discussed below, it is respectfully submitted that the originally filed disclosure clearly provides written description support for the subject matter claimed in claims 3, 5, 6 and 9-11.

More specifically, written description support for the invention as recited in claims 3 and 6 is provided on page 4, line 27 – page 5, line 4 of the specification as originally filed, which describes *exactly* the features recited in claims 3 and 6. Additional written description support for the features recited in claims 3 and 6 is provided, e.g., on page 7, lines 9-14 and page 14, lines 2-16 of the specification as originally filed.

Furthermore, written description support for the invention as recited in claims 5 and 9-11 is provided on page 5, lines 11–26 of the specification as originally filed, which describes *exactly* the particular features recited in claims 5 and 9-11. Additional written description support for the features recited in claims 5 and 9-11 is provided, e.g., on page 8, line 1 – page 11, line 18 of the specification as originally filed.

In view of the above remarks, it is respectfully submitted that the rejection under §112, first paragraph, is improper and should be withdrawn.

Claim Rejection—35 U.S.C. §112, second paragraph

Claims 3, 5, 6, 9-11 were rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness. More specifically, the Examiner alleges “Claims 3, 6, 5, 9-11 fail(s) to recite sufficient structural elements and interconnection of elements to positively position and define: 1) how the tape scale is detected by the detecting mechanism (claims 3, 6); 2) how the end plates perform as recited so that an integral structure able to function as claimed is recited.” Office Action, page 4, lines 3-7.

Claims 3 and 6

Claims 3 and 6 have been amended to obviate the 112, second paragraph, rejection by clarifying certain features. More specifically, claims 3 and 6 have been amended to clarify the relationship between the claimed “detecting mechanism” and the “tape scale”.

Claims 5 and 9-11

As will be discussed in detail below, it is respectfully submitted that the language of claims 5 and 9-11 is **not** indefinite or unclear under §112, second paragraph. Regarding §112, second paragraph, the MPEP §2173.02 states “If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made *and an analysis as to why the phrases(s) used in the claim is vague and indefinite should be included in the Office action.*” [Emphasis added.]

Initially, it is noted that the only analysis provided as to why the claim language of claims 5 and 9-11 is allegedly vague and indefinite is “Claims...5 [and] 9-11 fail(s) to recite sufficient

structural elements and interconnection of elements to positively...define...2) how the end plates perform as recited so that an integral structure able to function as claimed is recited.” Office Action, page 4, lines 3-7.

Therefore, as best understood, it seems that the Examiner is asserting that the claimed structure of the “end plates” (including how elements are connected or interrelated) is not capable of performing the claimed functions of the end plates (i.e., the Examiner asserts that the claims do not “recite sufficient *structural elements and interconnection of elements* to...define...*how the end plates perform as recited* so that an integral structure *is able to function as claimed* is recited”).

Accordingly, first, Applicants respectfully request that the Examiner *specifically* point out which claimed functions are not capable of being performed by the claimed structure. That is, the Examiner makes a broad allegation that there is insufficient structure to perform the claimed functions of the end plate, without pointing out which functions cannot be performed by the claimed structure.

Second, it is noted that the claims recite “end plates provided at both ends of said guide block body in the travel direction of said rail, said end plates each having rolling element *direction change passages* that form rolling element *recirculation passages* in cooperation with said load rolling element rolling passages and said rolling element relief bores”.

Thus, the only functions associated with the claimed “end plates” appear to be “direction change” and “recirculation”. However, the claim clearly recites “passages” that are the “direction change passages” and clearly recites that the “recirculation” is achieved by the

“direction change passages...in cooperation with said load rolling element rolling passages and said rolling element relief bores.”

Therefore, it is submitted that claims 5 and 9-11 clearly recite structure capable of performing the “functions” recited in these claims. Further, it is noted that the Manual of Patent Examining Procedure (MPEP) §2173.02 provides the following guidance regarding §112, second paragraph, rejections “Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the *particular application disclosure*;...and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” [Emphasis added]. As indicated by way of the examples of reference elements taken from the specification that correspond to elements recited in claims 5 and 9-11 listed below, it is submitted that the claims when considered in light of the specification clearly recite structure capable of performing the recited functions.

a guide block body having load rolling element rolling surfaces (e.g., 32-1, 32-2, 33-1, 33-2) that form load rolling element rolling passages (e.g., R1, R2, R3, R4) in cooperation with said rolling element rolling surfaces (e.g., 21-1, 21-2, 22-1, 22-2), said guide block body further having rolling element relief bores (e.g., 32-3, 32-4, 33-3, 33-4) associated with said load rolling element rolling surfaces (e.g., 32-1, 32-2, 33-1, 33-2); and

end plates (e.g., 34, 35) provided at both ends of said guide block body in the travel direction of said rail, said end plates each having rolling element direction change passages (e.g., R5, R6, R7, R8) that form rolling element recirculation passages in cooperation with said load rolling element rolling passages (e.g., R1, R2, R3, R4) and said rolling element relief bores (e.g., 32-3, 32-4, 33-3, 33-4)

Finally, it is pointed out that the MPEP §2173.04 instructs that breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). It is

acknowledged that claims 5 and 9-11 recite some aspects of the invention broadly. However, this does not equate with indefiniteness.

In view of the foregoing, reconsideration and withdrawal of the rejection under §112, second paragraph, are respectfully requested.

Claim Rejection – 35 U.S.C. §102

Claim 1 is rejected under 35 U.S.C. §102(b) as being anticipated by **Liu** (US Patent No. 4,694,132). For the reasons set forth in detail below, this rejection is respectfully traversed.

Initially, it is noted that claim 1 has been amended to clarify aspects of the claimed invention. That is, claim 1 has been amended to clarify a relationship between the rail and the guide block, and particularly, a manner in which the rail fits into a U-shaped opening in the guide block.

The **Liu** reference discloses a turntable for rotating food cooking in a microwave oven. The turntable 10 includes a table top platform including a circular platform 12. The table top platform rests atop a spider drive member 20 having an annular (i.e., ring shaped) portion 26 and first radial arms 18 and second radial arms 22 (see, e.g., Figs. 1 and 2 and col. 3, lines 17-20). As shown in Fig. 3, a retainer ring 28 is disposed below the annular portion 26 and the annular portion 26 has vertical projections 36 which straddle the retainer ring 28. The retainer ring loosely secures a plurality of spherical bearings 30 and the spider drive member 20 rides upon the spherical bearings 30 (see, e.g., col. 2, line 67-col. 3, line 2 and col. 3, lines 28-30).

The Examiner relies on Fig. 3 of the **Liu** reference to teach the features recited in claim 1 (see page 4 of Office Action). However, except for generally pointing out the turntable 10, the Examiner *does not point out any specific structure* shown in Fig. 3 that corresponds to the claimed elements. As best understood, the Examiner apparently considers the circular platform 12 of **Liu** to correspond to the claimed “rotary table”. Further, we assume that the Examiner considers the drive member 20 that supports the circular platform 12 and having *the annular (i.e., ring shaped) portion 26* to correspond to the claimed “guide apparatus including *a ring-shaped integrated rail* having no discontinuity in a travel section thereof”.

Finally, it is noted that the Examiner does not point out which elements in **Liu** are considered to correspond to the claimed “plurality of guide blocks that are assembled to said rail from a direction of their surfaces opposing said rail.”

As noted above, claim 1 has been amended to clarify a relationship between the rail and the guide block, and particularly, a manner in which the rail fits into a U-shaped opening in the guide block.

It is respectfully submitted that the **Liu** reference does not disclose or suggest “wherein a top surface of said rail opposite to a surface thereof opposing said guide blocks and an underside of said rotary table are joined together, and wherein each of said plurality of guide blocks includes a U-shaped cross-sectional opening and a portion of said rail is fitted into the U-shaped cross-sectional opening from the above the opening,” as currently recited in claim 1.

A rejection under §102 requires that each and every element recited in the claim must be disclosed in the prior art reference, and must be arranged as in the claim. It is submitted that **Liu**

does not teach each and every element recited in claim 1 arranged as in the claim. Accordingly, it is respectfully submitted that the rejection of claim 1 under §102 is improper and should be withdrawn.

Claim Rejections – 35 U.S.C. §103

Claims 2, 4, 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Liu** in view of **Takei et al.** (USP 5,575,565). Claims 3 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Liu** in view of **Gilberti** (USP 5,784,932). Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over **Liu** in view of **Takei et al.** and further in view of **Gilberti**.

It is submitted that neither **Takei et al.** nor **Gilberti** alleviate any of the deficiencies of **Liu** discussed above with respect to claim 1. Therefore, each of claims 2, 3, 4, 6, 7 and 8 patentably distinguish over the combinations of references for the same reasons set forth above with respect to claim 1 by virtue of their dependency on claim 1.

Claims 5 and 9-11

As noted above, claims 5 and 9-11 were not rejected in view of prior art. Therefore, it is submitted that claims 5 and 9-11 should now be allowable. Therefore, in the next Office Action, the Examiner is respectfully requested to either (1) indicate that claims 5 and 9-11 are allowable, or (2) issue a new non-final Office action that rejects these claims in view of prior art.

Application No.: 10/586,482
Art Unit: 3637

Amendment under 37 C.F.R. §1.111
Attorney Docket No.: 062661

CONCLUSION

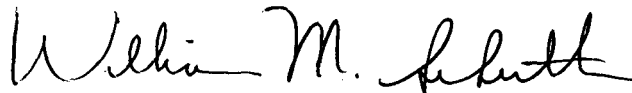
In view of the foregoing, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



William M. Schertler
Attorney for Applicants Registration No. 35,348
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

WMS/ar

Attachments: Replacement Sheet of Fig. 5